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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/629,464	07/31/2000	Hiroyuki Sayuda	046601-5056	5381
9629 7590 08/02/2007 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			EXAMINER THOMPSON, JAMES A	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 08/02/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/629,464

**Applicant(s)**

SAYUDA, HIROYUKI

**Examiner**

James A. Thompson

**Art Unit**

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION*****Response to Arguments***

1. Applicant's arguments filed 10 July 2007 have been fully considered but they are not persuasive. Examiner agrees with Applicant that Reber (USPN 6,138,151) does not fully anticipate the presently amended independent claims. However, Reber when combined with additional prior art, which was previously cited, does render the claims obvious to one of ordinary skill in the art at the time of the invention. Accordingly, new rejections under 35 USC §103(a) are set forth below. The new rejections are thus a full and complete response to Applicant's present arguments. The new grounds of rejection set forth below have been necessitated by the present amendments to the claims. Therefore, the present action is made final.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 25-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber (US Patent 6,138,151) in view of Bhattacharjya (US Patent 6,456,393 B1).**

**Regarding claims 25 and 31:** Reber discloses an image processing apparatus (figure 1 of Reber) comprising an image data generation unit (figure 1(42) of Reber) that generates an image data including an image element (*article*) based on a document data (column 3, lines 36-44 of Reber – *document divided into articles, said articles corresponding to the image elements*), the document data including link information (column 3, line 65 to column 4, line 4 of Reber) that indicates a location of related information related to the image element (column 5, lines 57-65 of Reber) and appearance information that defines a position (*where article is located in document*) of the image element in the image data (column 3, lines 38-48 of Reber); an embedding data generation unit (figure 1(46) of Reber) that receives identification information corresponding to the link information (column 6, lines 10-24 of Reber) and is smaller than the link information in data size (column 5, lines 11-17 of Reber), and configured to generate a control data to embed the identification information adjacent to the image element (*next to the article*)

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based on the appearance information (column 7, lines 7-17 of Reber); and an embedded image formation unit (figure 1(62) of Reber) that generates pixel data to be formed on a recording medium based on the image data and control data (column 7, lines 12-28 of Reber), the pixel data including the identification information adjacent to the image element (column 7, lines 12-17 and lines 46-53 of Reber), wherein the image element excludes any one of the link information, the related information, and the identification information (column 7, lines 12-17 of Reber – *embeded codes printed next to image element (article), and are not a part of the image element*).

Reber does not disclose expressly that said identification information is embedded by *superimposing over* said image element.

Bhattacharjya discloses embedding document codes by superimposing the document codes over the image elements (figure 5 and column 3, lines 44-61 of Bhattacharjya).

Reber and Bhattacharjya are combinable because they are from the same field of endeavor, namely embedding document codes into printed document data. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to embed the identification information taught by Reber by superimposing said identification information of the image element, as taught by Bhattacharjya. In Bhattacharjya, the coded information is also not a part of the image element, but is embedded onto the image element. The motivation for doing so would have been to embed the code such that the code is identifiable by an electronic machine, but maintains the same document appearance to the human eye (column 1, lines 50-63 of Bhattacharjya). Such a modification would be provide a notable improvement of the system of Reber which uses human noticeable bar codes, which takes away from the aesthetic appeal of the printed document. Therefore, it would have been obvious to combine Bhattacharjya with Reber to obtain the invention as specified in claims 25 and 31.

Further regarding claim 31: The apparatus of claim 25 performs the method of claim 31.

**Regarding claims 26 and 32:** Reber discloses that the link information is URL (column 5, lines 25-28 of Reber).

**Regarding claims 27 and 33:** Reber discloses an image forming unit (figure 6(63) and column 6, lines 25-30 of Reber) that forms the pixel data on the recording medium in a state that the identification information is accessible by a user (column 3, lines 15-20 of Reber).

**Regarding claim 28:** Reber discloses an identification information management unit (figure 1 (52) and column 4, line 62 to column 5, line 10 of Reber).

**Regarding claims 29 and 34:** Reber discloses that the embedding data generating unit extracts the link information from the document data (column 6, lines 23-37 of Reber), registers the extracted link

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information in the identification information management unit (column 8, lines 32-43 of Reber), and receives the identification information corresponding to the link information from the identification information management unit in response to the registration (column 8, lines 32-43 of Reber).

**Further regarding claims 30 and 35:** Bhattacharjya discloses that the embedded image formation unit generates the pixel data in a form or in a color that is difficult to identify the identification information visually (figure 5; column 1, lines 58-63; and column 3, lines 44-49 of Bhattacharjya).

### *Conclusion*

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Thompson whose telephone number is 571-272-7441. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James A. Thompson  
Examiner  
Technology Division 2625



JAT  
22 July 2007

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